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EXAMINER

RAMAN, USHA

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/725,987	Applicant(s) YOSHIDA ET AL.	
	Examiner USHA RAMAN	Art Unit 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 26,27,29,30 and 32-40 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 26,27,29,30 and 32-40 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>200110909</u> . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Response to Arguments

1. Applicant's arguments with respect to claim 26 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

2. On September 8, 2011, claim language was proposed to be included as examiner's amendment to the applicant's attorney, Thomas Presson. The proposed claim language as discussed with Mr. Presson is included in the attached Interview Summary form.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 26-27, 29-30, 32-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 26, 29, 32, and 34 all recite the limitation, "wherein the selective information includes an accounting amount which is changed in response to...". Applicant's disclosure notes that the *attributive* information includes an accounting amount ([0032] of published application) wherein the accounting amount can be changed by the broadcasting station based on various information communicated

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from the receiver (e.g. [0061], [0062], [0083], [0092], [0098], [0099] of published application). Applicant's disclosure does not disclose or contemplate that the selective information comprises an accounting amount wherein filtering maybe done on the basis of the accounting amount (when included in the selective information) or that the accounting amount included in the selective information is changed on the basis of the recited factors. Rather the accounting amount appears to be changed by the broadcasting station based on various information communicated from the receiver to the broadcasting station, as noted above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 26-27, 29-30, 32-36, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Killian (US Pat. 6,163,316) in view of Hassell (US Pat. 2004/0128685), Fullerton et al. (US PG Pub. 2005/0223407), Itoh (US PG Pub. 2003/0206632) and Murphy (US Pat. 6,564,380).

With regards to claims 26, 29, 32, and 34, Killian discloses a receiver comprising:

A receiving means (10) for receiving digital content and attributive information (see column 3 lines 59-67, column 4 lines 1-7) from a broadcast station (col. 3, lines 50-58), the receiving means including an infra-red radiation receiving unit (col. 4,

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lines 47-50, wherein infrared signals from remote control are input to receiver 44 of receiver 10 and therefore the receiver 10 comprises a IR receiving unit 44);

Remote controller means (42), which includes an infrared emitting unit (col. 4, lines 47-50, wherein because infrared signals from remote control are input to receiver 44, the remote control emits IR signals to the receiver 44) for remotely controlling the receiving means (col. 4, lines 61-64, e.g. remotely controlling receiving means by changing channels) by transmitting an infrared radiation signal (i.e. input signals from the remote control to the receiving unit are infrared signals) from the infrared radiation emitting unit to the infrared radiation receiving unit (44) in the receiving means, wherein the remote controller means is separate from the receiving means (see fig. 1, wherein 42 is illustrated as being "separate" from 10).

Selecting means for comparing a first selective information with the attributive information (see column 2 lines 19-22 and column 17 lines 29-35)

A filtering means for filtering the attributive information on the basis of the first selective information to select the digital content (see column 10 lines 60-67, column 15 lines 5-12); and

Recording means for recording on the receiver digital content selected on the basis of the first selective information (column 15 lines 5-12), wherein Killian additionally discloses that program information pertaining to programs can comprise address information of digital content to the broadcast station (col. 5, lines 10-21).

Killian does not discloses the receiver further comprising a removable recording medium control means for recording at least one of the selected digital

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content, and for storing address information of digital content to the broadcast station, on the removable recording medium, wherein the selected digital content recorded on the removable recording medium is reproducible on the display unit of the remote controller means. Killian additionally silent on wherein the remote controller means comprises a display unit and a removable recording medium, wherein the digital content recorded on the removable recording medium can be reproduced on the display of the remote controller means.

In an analogous art, Hassell discloses a method of recording programs on a removable storage medium [0019] [0020]. Hassell accordingly discloses a removable recording medium control means for recording at least one selected digital content on the removable recording medium. Hassell additionally discloses that storing the program information (i.e. associated program data) pertaining to recorded programs on the removable storage medium [0052], wherein such program information may comprise internet links.

Fullerton discloses portable remote control (UTV remote) that is capable of commanding channel selection/channel change of a receiver (i.e. base unit, [0006], [0008], fig. 6), wherein the portable remote control has the ability to render video for display [0034]. Fullerton further notes that such a portable remote control maybe implemented on a laptop computer [0023] capable of playing back stored or taped movie [0034]. While Fullerton is silent that the laptop computer comprises removable recording medium, examiner takes Official Notice that laptop computer

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comprising removable recording medium and capable of reading the removable recording medium were well known in the art at the time of the invention.

It would have been obvious to one of ordinary skill in the art to modify the system in view of Hassell and Fullerton's teachings by facilitating a removable recording medium for storing program and program information therein, wherein the program information additionally comprises address information of digital content to the broadcast station so that viewer can access internet information pertaining to selected digital content. It would have been obvious to one of ordinary skill in the art to further modify the remote controller of Killian in view of Fullerton by employing a remote controller with display such as a laptop computer that can effect channel change and display programming on the "remote controller" and further modify it to incorporate a removable recording medium so that the "remote controller" can additionally render for display programs stored in the recording medium.

The modified system is however silent on wherein the attributive information including an accounting amount which is changed in response to using environment of each user, amount of commercial message listened to and viewed by each user, numbers of request for a program by each user, and is variable when a first user introduces a program to a second user and the second user uses the introduced program.

In an analogous method, Itoh discloses a method wherein accounting amount for a program can be changed based amount of commercial message listened

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to/viewed by each user [0044], is variable when a first user introduces a program to a second user and the second user uses the introduced program [0011], [0092].

In a further analogous art, Murphy also discloses the step of determining accounting amount of a program based on using environment of each user (i.e. quality of video), and the demand for the video col. 13, lines 1-4, 17-19.

Accordingly it would have been obvious to one of ordinary skill in the art to further modify the system in view of Itoh and Murphy's teachings by varying pricing structure on factors such as dispersed copies of movies, amount of commercial usage in a program, quality of the viewed program and demand for the program, thereby allowing a flexible pricing scheme.

With regards to claims 27, 30, 33 and 35, the system as modified in view of Hassell further comprises removable recordable medium means (see [0008]) configured to store client identification (user information stored in user fields, see [0045]).

With regards to claim 36, the modified system discloses the step of a user storing programs to digital storage device (see Hassell: [0084]) and providing to playback of contents at the storage device at a remote controller (Fullerton: [0034]). The modified system further discloses the step of automatically without receiving user intervention and playing user media (once the storage medium is loaded) based on address information of digital content and client identification stored on the address information of digital content (Hassell: [0089]). The modified system additionally comprises multiple remote controller devices as taught by Fullerton (see

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fig. 6), wherein each remote controller device maybe a laptop comprising a removable recording medium and capable of reading the removable recording medium, as discussed above in claim 1. Accordingly, the removable medium can be rendered for playback in a first remote controller or second remote controller means.

With regards to claim 38, the modified system further discloses wherein the parameter of the first selective information is set to exclude programs from being recorded and reproduced. See Killian: column 14 lines 42-55 and column 16 lines 55-57.

7. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Killian (US Pat. 6,163,316) in view of Hassell (US Pat. 2004/0128685), Fullerton et al. (US PG Pub. 2005/022340), Itoh (US PG Pub. 2003/0206632) and Murphy (US Pat. 6,564,380) as applied to claim 29 above and further in view of Herz (5,758,257)

With regards to claim 37, the system of claim 29 as modified is silent on the step of analyzing user's tasted based on a reproduced program and changing weighting of a value of a parameter of the first selective information based on the analysis of user's taste thereby changing the filter configured to filter the attributive information to select the digital content. In a related art of suggesting programs, Herz discloses a method of analyzing suggested programs that a user has watched or not watched in order to adjust weights associated with the customer profile. See column 25 lines 45-48, column 26 lines 63-column 27 line 2. It would have been obvious to one of ordinary skill in the art to further modify the system in view of

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Herz's teachings by adjusting user profiles based on programs so that suggestion algorithms can be updated by monitoring suggested programs were watched.

8. Claims 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Killian (US Pat. 6,163,316) in view of Hassell (US Pat. 2004/0128685), Fullerton et al. (US PG Pub. 2005/022340), Itoh (US PG Pub. 2003/0206632) and Murphy (US Pat. 6,564,380) as applied to claim 30 above, and further in view of Zigmond et al. (6,698,020)

With regards to claim 39, while the system of claim 30 as modified discloses displaying commercials during commercial breaks (Killian: col. 5, lines 62-66), Killian is silent on the step of selecting commercial information based on the first selective information and storing the commercial in a dedicated area of the recording medium.

Zigmond discloses the step of storing commercials that match a user profile (see column 19 lines 55-61).

It would have been obvious to one of ordinary skill in the art to further modify the system in view of Zigmond teachings by recording advertisements that match the viewer profile (first selective information) so that the system can display targeted advertisements during commercial breaks.

With regards to claim 40, the stored commercial in the modified system is reproduced within a predetermined time frame (upon detecting triggering event, see Zigmond: column 20 lines 4-7).

Conclusion

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9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to USHA RAMAN whose telephone number is (571)272-7380. The examiner can normally be reached on Mon-Wed, Fri: 5:00am-9:00am; Thu: 5:00am-7:00am and 12:00pm-2:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pankaj Kumar can be reached on (571) 272-3011. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Usha Raman/

/Pankaj Kumar/

Supervisory Patent Examiner, Art Unit 2424